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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/684,113

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Vijay R. Mhetar

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EXAMINER

YOON, TAE H

ART UNIT

PAPER NUMBER

1762

NOTIFICATION DATE

DELIVERY MODE

03/08/2012

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

usptopatentmail@cantorcolburn.com

Office Action Summary	Application No. 10/684,113	Applicant(s) MHETAR, VIJAY R.	
	Examiner TAE H. YOON	Art Unit 1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2012.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 17, 18 and 22-33 is/are pending in the application.
- 5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 17, 18 and 22-33 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) ☐ Notice of References Cited (PTO-892) | 4) ☐ Interview Summary (PTO-413) |
| 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) ☐ Information Disclosure Statement(s) (PTO/SB/08) | 5) ☐ Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) ☐ Other: ____. |

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17, 18 and 22-33 are rejected under 35 U.S.C. 103(a) as obvious over White et al (US 4,760,118) in view of Geprags et al (US 2003/0130403 A1), Adedeji et al (US 6,872,777) and/or Jalbert et al (US 4,654,405).

Rejection is maintained for reason of record with following response.

Example 4 of White et al teaches an extrusion of the polyphenylene ether (PPO) with a capping agent added downstream and table III shows use of 4 wt.% of polysalicylate which has yielded 86% capping (14 % uncapped hydroxyl group). Again, White et al teach utilizing various amounts of polystyrene such as 5-95% and thus the use of 5 wt.% of polystyrene with 4 wt.% of polysalicylate in the table III would be a *prima facie* obviousness.

Furthermore, utilization of the art well-known additives of Geprags et al, Adedeji et al and/or Jalbert et al in the example of said table III in order to improve known properties such as increased impact strength (impact modifier), improved various mechanical properties (reinforcing filler) and impart flame retardancy (flame retardant) would be also a *prima facie* obviousness.

Selection of a known material based on its suitability for its intended use is *prima facie* obvious, see Sinclair & Carroll Co. v. Interchemical Corp., 325 US 327, 65 USPQ 297 (1945). The combination of familiar elements according to known methods is likely

to be obvious when it does no more than yield predictable results. KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 416 (2007).

Applicant asserts that comparison of Comparative examples 7 and 8 and Example 10 shows that SEBS has yielded markedly different retention of tensile strength after aging. However, a fair comparison cannot be made since the Comparative examples 7 and 8 contain HIPS but Example 10 contains XPS. A fair example 10 should be 50 wt.% PPO, 42.5 wt.% HIPS, 7.5 wt.% SEBS and 2.5 wt.% polysalicylate.

The original Examples 2, 3, 5 and 6 in the instant table 2 actually fall within scope of examples 3 and 4 of White et al. Comparison of said Examples 2, 3, 5 and 6 with Comparative examples 1 and 4 shows that the polysalicylate has yielded improved retention of tensile strength after aging. Thus, an addition of other components such as an impact modifier (SEBS) would have increased tensile strength after aging which is expected.

Also, only Examples 10, 13 and 16 of the table 2 fall within scope of the claims and note that White et al teach an extrusion of PPO and polysalicylate. Thus, a fair comparison of the Example 13 should be against a composition comprising PPO and polysalicylate, not against Comparative example 11 without polysalicylate.

The applicants have not established that the evidence in the applicants' specification provides a comparison with **the closest prior art**. See *In re Baxter Travenol Labs.*, 952 F.2d 388, 392 (Fed. Cir. 1991); *In re Blauwe*, 732 F.2d at 705, or is

commensurate in scope with the claims. Applicants must also explain why the showing is commensurate in scope with the claimed subject matter. See *In re Boesch*, 617 F.2d 272, 276 (CCPA 1980).

Even if somehow there is unexpected result (the examiner does not think as though), the scope of claims is broader than showing. The scope of claim 17 encompasses 99 wt.% of PPO and 1 wt.% of the recited additive with 2.5-4 wt.% of polysalicylate. The scope of claim 32 encompasses 95 wt.% of PPO and 5 wt.% of the recited additive with 2.5-4 wt.% of polysalicylate. Also, see following case-laws.

Whether an applicant seeks to establish an unobvious difference to overcome an inherency finding or unexpectedly improved results to overcome an obviousness conclusion, the objective evidence an applicant provides must be commensurate in scope with the claims which the evidence is offered to support. In other words, the showing must be reviewed to see if the results occur over the entire claimed range. In *re Marosi*, 710 F.2d 799, 803 (Fed. Cir. 1983); *In re Clemens*, 622 F.2d 1029, 1035-36 (CCPA 1980); *In re Peterson*, 315 F.3d 1325, 1330-31 (Fed. Cir. 2003); *In re Grasselli*, 713 F.2d 731, 743 (Fed. Cir. 1983).

In summary, the table III of the closest prior art (White et al) teach the extrusion of the polyphenylene ether (PPO) with 4 wt.% of polysalicylate. Thus, comparison should be based on said example with an addition of the recited (minimum) amount of additives for the claims 17, 18, 22-25, 27, 28 and 30-33. For additional claims 26 and

29, White et al further teach employing polystyrene. The combination of components polysalicylate and polystyrene would be obvious since both species have been used in working examples. In re Kerkhoven, 205 USPQ 1069 (CCPA 1980).

Applicant failed to show any unexpected result.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAE H. YOON whose telephone number is (571)272-1128. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1762

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/TAE H YOON/
Primary Examiner
Art Unit 1762

THY/March 5, 2012